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REMARKS

Claims 1-20 were pending in the present Application. Claims 1- 12, and 14-15 have been canceled, and Claim 13 has been amended, leaving Claims 13 and 15-20 for further consideration upon entry of the present Amendment.

No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 12 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection has been rendered moot in view of the cancellation thereof.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-4, 12 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by any one of Rogers, Cole et al., or Plaid so Beautiful. Applicants respectfully traverse this rejection.

The rejection has been rendered moot in view of the cancellation thereof.

Claim Rejections Under 35 U.S.C. § 103(a)

A. Claims 1-3, 6-9, 11-13, 16-20 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Caiati in view of any one of Wendt, 3M, or Burnell-Jones. Applicants respectfully traverse this rejection.

Caiati is generally directed to installation of sunroofs and T-Tops. There is no disclosure or suggestion as to methods for providing light into a vehicle interior apart from the

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transmission of natural daylight through the sunroof or a vehicle sunroof assembly having a panel comprising a phosphorescent material and a light-transparent component phosphorescent. Moreover, the decorative coatings are described as paints and films.

Wendt is generally directed to coated glasses and method for their manufacture.

The 3M reference is generally directed to a specific product, namely Luminous Film 6900. There is no disclosure or suggestion of a sunroof assembly. The Figure in the brochure illustrates an "exit" sign and a "step up" sign. Moreover, according to the brochure, the luminous film includes a "glow in the dark" component that is purportedly rechargeable. There is no disclosure as to the composition of the "glow in the dark" component.

Burnell-Jones is generally directed to luminescent gel coats and moldable resins.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicants respectfully assert that a *prima facie* case of obviousness has not been established against Claims 13-20. A *prima facie* case of obviousness has not been established against independent Claim 13 because none of the references teach or suggest a sunroof assembly comprising, *inter alia*, a phosphorescent material dispersed within a matrix of a light-transparent component. With regard to independent Claim 19, there is no disclosure or suggestion of a method for providing light into an interior of a vehicle as claimed.

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In the cited references, the phosphorescent material is consistently characterized as a coating. For example, Burnell-Jones generally teaches and suggests the use of gel coats. Similarly, Wendt teaches and suggests coatings for fireproof glazed glass. This is markedly different from a phosphorescent material dispersed within a matrix of a light-transparent component. Moreover, with regard to Wendt, it should be noted that the use of a glazed glass would likely not be suitable for Applicants intended purpose, namely a sunroof assembly. Light transmission would be poor and as a result, excitation of the phosphorescent material would be impeded by the diffraction caused by the glazing, thereby limiting its effectiveness as well as the transmission of light through the sunroof assembly.

In applying Section 103, the U.S. Court of Appeals for the Federal Circuit has consistently held that one must consider both the invention and the prior art "as a whole", not from improper hindsight gained from consideration of the claimed invention. See, *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) and cases cited therein. According to the *Interconnect* court:

[n]ot only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time - a technician without our knowledge of the solution.

Id. Also critical to this Section 103 analysis is that understanding of "particular results" achieved by the invention. *Id.*

When, as here, the Section 103 rejection was based on selective combination of the prior art references to allegedly render a subsequent invention obvious, "there must be some reason for the combination other than the hind sight gleaned from the invention itself." *Id.* Stated in another way, "[i]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch* 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). In view of the multitude of references cited in the Office Action, it appears that the rejections are improperly based on hindsight.

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It is also well established that a finding of "obvious to try" does not provide the proper showing for an obviousness determination. The requirement for a determination of obviousness is that "both the suggestion and the expectation of success must be founded in the prior art, not in applicant's disclosure" (emphasis added). *In re Dow Chem.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). An Examiner, then, cannot base a determination of obviousness on what the skilled person in the art might try or find obvious to try. Rather, the proper test requires determining what the prior art would have led the skilled person to do.

In the present case, there is no suggestion of a sunroof assembly as claimed. With regard to the Burnell-Jones reference, the disclosed automotive applications for its luminescent polymers are generally defined by their thermoluminescence behavior (activated by heat sources) such as "body heat, motor heat, brake heat, and hot water" (See Burnell-Jones, Col. 8.11. 36-42) or are for the purpose of automotive markings, e.g., license plates, emergency vehicle ID and markings, parking/ headlight lamps, taillight lenses (see Burnell-Jones, Col. 10, 11. 35-36 and 52-59). There is not suggestion of a sunroof assembly comprising a phosphorescent material and a light-transparent component as presented in Claim 13. Likewise, there is no teaching or suggestion of a method for providing light into an interior of a vehicle as in Claim 19. Nowhere in the cited references is there a disclosure or suggestion of the claimed method of providing light into the interior of the vehicle.

Accordingly, it is requested that the rejection be withdrawn.

B. The remaining rejections applied to Claims 4, 5, 14, and 15 under 35 U.S.C. § 103(a) have been rendered moot in view of their cancellation.

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It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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